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OFFICE OF PETITIONS

In re Application of :
Ravi Hariprasad, Rajesh Ghanta, : DECISION REFUSING
Praveen Ghanta and Ravi Ghanta : STATUS UNDER
Application No. 10/728,249 : 37 CFR 1.47(b)
Filed: December 4, 2003 :
Attorney Docket No. 291966-00003 :

This is in response to the petition under 37 CFR § 1.47(b), filed September 13, 2004.

The petition under 37 CFR § 1.47(b) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on December 4, 2003, without an executed oath or declaration, missing the statutory basic filing fee, and with additional claim fees due. Accordingly, on June 25, 2004, applicants were mailed a "Notice to File Missing Parts of Application," requiring submission of an executed oath or declaration, payment of the basic filing fee, and payment of a surcharge for late filing under § 1.16(1). This Notice set a period for reply of two months, with extensions of time obtainable under § 1.136(a).

With the instant petition, petitioner submitted a DECLARATION OF ASSIGNEE FOR UTILITY PATENT APPLICATION (37 CFR 1.63) executed by Duncan Mackay for the assignee with a 3.73(b) statement, and paid the outstanding fees. To make the reply time, the petition was accompanied by a petition for extension for response within the first month (and fee). A declaration signed by less than all of the inventors is not a proper reply to the Notice of Missing Parts, except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

§ 1.47(b) provides that:

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

Accordingly, a grantable petition under 37 CFR §1.47(b) requires: (1) an acceptable oath or declaration in compliance with 37 C.F.R. §1.63 and 1.64 or 1.175; (2) the rule 47 applicant must state his or her relationship to the inventor as required by 37 C.F.R. §1.64; (3) proof that the non-signing inventor cannot be found or reached after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; (6) that rule 47 applicant make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention; and (7) rule 47 applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See MPEP § 409.03(g).

See 35 U.S.C. §118; 37 C.F.R. §1.47; §§ 409.03 and 605 of the *Manual of Patent Examining Procedure* (8th ed)

The petition includes the petition fee and the inventors' last known addresses. An assignment of the instant application to rule 47(b) applicant is of record in the Office.

However, the instant petition lacks requirements (1), (2), and (3) and (7):

As to items (1) and (2),

The declaration submitted is executed by Duncan Mackay on behalf of all of the inventors. Furthermore, the petition includes a 3.73(b) statement that Mr. Mackay is authorized to sign on behalf of the assignee. However, title of Mackey ...

Moreover, where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must still state the full name, residence, post office address, and citizenship of the non-signing inventor. See MPEP 409.03(b). As stated in the Notice mailed October 7, 2004, the instant declaration does not include the citizenships of the non-signing inventors. Moreover, identifying of the citizenship of the inventors is a statutory requirement and thus, cannot be waived. It is not sufficient to state "citizenship unknown."

In addition § 1.64(b) provides that:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. The instant declaration does not state the relationship of Mr. Mackey to the inventors.

As to item (3),

Petitioner has not shown that the inventors, by their conduct, have refused to join in the application. Before a refusal can be alleged, applicant must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence on petition only supports a conclusion that the combined declaration and power of attorney and assignment were

sent to the non-signing inventors. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicant must establish that the entire application package, including specification, claims and drawings, were presented to the non-signing inventors and they subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventors, or, if the inventor(s) are represented by counsel, to the address of the non-signing inventors' attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

As to item (7),

Petitioner makes no assertion. On request for reconsideration, rule 47 applicant must submit proof of irreparable damage. See MPEP §409.03(g).

On Request for Reconsideration, to avoid abandonment and attain 1.47 status, applicant must correct the noted deficiencies and provide a 1.47 petition in compliance with all applicable law.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (703) 872-9306
 ATTN: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3219.



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